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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,931	01/24/2001	Satoshi Kanayama	55551-CIP(1360)	3848

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,931

Applicant(s)

KANAYAMA ET AL

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The PCT priority document has not been received.

Claims 1-6 and 8-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 depends on a cancelled claim.

Applicant's remarks indicate claim 1's description of (b) is limited to aliphatic diols, aromatic diols and ethylene oxide adducts of aromatic diols. The claim language does not clearly make such a limitation (b) "comprises" two diacids and at least one diol selected from aliphatic/aromatic/EO adducts of aromatic diols. This merely positively requires one of the subsequently named types of diols to be present. It does not prohibit other types of diols to be present. Note that applicant's specification (page 10, line 21) calls for other diols such as cyclohexane dimethanol. Applicant should use language such as "all the diols present are selected from..." instead of "the at least one diol moiety consisting of at least one kind of diol moiety".

Claims 1-6, 8-13, 20, 22, 23 and 25 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Harada Patent.

The Harada blends copolyester with polycarbonate in a 2/98 to 95/5 ratio (column 8, line 4). The polyester has 30-90% of its acid being naphthalene dicarboxylic acid (column 3, line 30). Example 88 and comparison 25 are particularly relevant. Stabilizers (column 5, lines 16-17) can be present.

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Claims 1-6, 8-15, 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Harada Patent in view of Allen and Hirose.

Harada does not suggest sterilizing his blend or adding radiation stabilizers.

Allen teaches (column 2, line 26) blends of PC and copolyester can be sterilized by radiation. Also note, Allen suggests naphthalene dicarboxylic acid units (column 4, line 41) in the copolyester.

Hirose teaches a certain radiation stabilizer for PC/polyester blends (col 7 line 15-20). Furthermore, Hirose teaches other stabilizers such as phosphates (column 6, line 5), triazines, phenols (column 7, line 31) and ester lubricants (column 7, line 30) are appropriate inclusions.

It would have been obvious to include any common additive to Harada's blend for the expected advantages and irradiate the final product for sterilization.

Claims 1-6, 8-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Harada Patent in view of Mizutani.

Harada does not suggest lubricants/release agents for his PC composition. Mizutani lists many release agents known for use with PC (column 5, lines 1-21). Use of any of these fatty acid esters and/or fatty alcohol esters would have been prima facie obvious.

Mizutani also teaches PC is radiation sterilizable with the inclusion of polyester radiation stabilizers and phosphates (column 5, line 22).

Applicant's arguments filed June 5, 2003 have been fully considered but they are not persuasive.

Applicant argues Harada requires an alicyclic diol.

This is true, but as explained above, applicant's claims do not prohibit alicyclic diols from being present.

Application 9-744285 is abandoned and therefore obviousness double patenting is no longer warranted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/dh
August 21, 2003

David Buttner